

REMARKS

Claims 1-22 are pending, while claims 1-22 stand rejected under §103(a). Claims 1-10 have been canceled and claims 23 and 24 are newly added. Claims 11, 15, and 17 have been amended leaving claims 11-24 for consideration upon entry of this amendment. No new matter has been added.

§112 REJECTIONS

Claims 15 and 17-22 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse.

The Examiner alleges that claim 15 is confusing in that it recites language drawn to cooperation with an outlet receptacle, however, claim 11 is for use with a service line within an electrical distribution panel and that claim 17 is confusing with the open-ended language "panelboard or the like". Claim 11 has been amended to claim cooperation with one of an electrical distribution panel and an outlet receptacle. Furthermore, claim 17 has been amended to cancel the alleged open-ended language "panelboard or the like".

Thus, it is respectfully requested that the rejection to claims 15 and 17-22 be withdrawn.

§103 REJECTIONS

Claims 1 - 7, 10-14 and 16 - 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abraham (5,625,863) in view of Dickens et al. (5,825,598). Applicants respectfully traverse.

Claims 1-7, and 10 have been canceled, so any rejection to them is rendered moot.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art

must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

Neither Abraham nor the power-line coupler art as a whole provide a reason for one of ordinary skill in the art to modify the Dickens reference in the manner required to meet claims 11 and 17. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification' ") (citation omitted); *In re Stencel*, 828 F.2d 751, 755, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987) (obviousness cannot be established "by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made"). There is no teaching or suggestions to combine elements of the prior art to produce the present invention. The present invention is thus nonobvious.

Applicants further maintain that the Examiner has used an improper standard in arriving at the rejection of the above claims under section 103, based on improper hind sight which fails to consider the totality of applicant's invention and to the totality of the cited references. More specifically the Examiner has used Applicant's disclosure to select portions of the cited references to allegedly arrive at Applicant's invention. In doing so, the Examiner has failed to consider the teachings of the references or Applicant's invention as a whole in contravention of section 103, including the disclosures of the references which teach away from Applicant's invention. (See Figure 43 of Abraham reference and Col. 14, lines 9-12 of the Dickens reference).

Section 103 sets out the test for obviousness determinations. It states, in pertinent part, that such determinations are to be made by consideration of

... the differences between subject matter sought to be patented and the prior art such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the [pertinent] art.

In making a Section 103 rejection, the Examiner bears the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1998). The Examiner "... can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references". *Id.*

In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art "as a whole", not from improper hindsight gained from consideration of the claimed invention. See, *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court

[n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution.

Id. Also critical to this Section 103 analysis is that understanding of "particular results" achieved by the invention. *Id.*

When, as here, the Section 103 rejection was based on selective combination of the prior art references to allegedly render a subsequent invention obvious, "there must be some reason for the combination other than the hind sight gleaned from the invention itself." *Id.* Stated in another way, "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch* 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness

without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (**The level of skill in the art cannot be relied upon to provide the suggestion to combine references.**). (Emphasis added.) MPEP 2143.01

The Examiner alleges that Abraham discloses bandpass filtering across the phase lines of an electrical distribution system so as to allow for data/communication through the AC power lines. See Figures 7, 22 - 26 and 35. See also Column 6, lines 60 - 65 and Column 7, lines 35 - 42 for Claims 6, 10, 16 & 22. The Examiner admits that Abraham does not disclose details about the housing and terminals, and for Claims 2, 12 & 18, the use of surge arrester circuitry.

However, the Examiner alleges that Dickens et al. teach the use of surge arrester circuitry with an electrical distribution system, an electrical distribution panel and multiphase load center. The Examiner also alleges that Dickens further teaches the use of a housing to house both surge arrester circuitry and filtering circuitry (see Figs. 2b, 4a and 4b).

More specifically, the Examiner points to Figure 2b, connection of housing (22) to the panel is shown; Fig. 4a illustrates the stabs (J1, J2) high potential terminals and low potential terminal (19) and Fig. 4b illustrates the combined surge arrester circuitry (section 1) along with filtering circuitry (section 2). The Examiner concludes that it would have been obvious to incorporate the teachings of Dickens et al. as a means to conveniently provide not only bandpass filtering for communication within a residence across the AC power lines, but to also house the bandpass filtering along with the arrester protection within a single housing easily attached at the panelboard within a residence, thereby easing implementation of AC power line communication and increasing protection from transients.

It is respectfully submitted that Dickens et al., on the contrary, teaches away from employing the filtering circuitry (section 2) as suggested above by the Examiner. More specifically, Dickens et al. teaches that (section 2) includes "filter 140 is designed to effectively short high-frequency arcing fault signals from line bus L1 to neutral bus N, **thus preventing arcing fault signals on line bus L1 from crossing over to line bus L2.**" (Emphasis added.)

Col. 14, lines 3-12. Thus, Dickens et al. teach away from signal communication between lines L1 and L2 or transfer of a signal having a predetermined frequency or frequency range between said at least two high potential terminals, as in claim 11 and similarly claimed in claim 17.

In addition, Abraham discloses only coupling of in wall wiring via conventional 120V (single phase) outlets within a residence. (See Abstract and Summary of the Invention). There is no teaching of coupling lines of 220/240V source or 2 or more discrete lines of a voltage source other than the "general case" of the three phases interconnected for communicating purposes illustrated in Figure 35 and disclosed at col. 18, lines 11-18 and those disposed outside of the residence as in Figure 43. Furthermore, Figures 7 and 22-26 relied on by the Examiner teach coupling to a single phase. There is no teaching or suggestion of such a phase coupler adapted for connection with an electrical distribution panelboard or an outlet receptacle having at least two high potential lines being phased coupled therein, as in claims 11 and 17.

Accordingly, it is respectfully requested that the rejection to claims 11 and 17, including rejected claims depending therefrom, i.e., claims 12-14 and 18-22, be withdrawn.

Claims 8, 9 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Abraham in view of Dickens et al. and Cooper et al. (4,630,163). Applicants respectfully traverse.

Claims 8 and 9 have been canceled, so any rejection to them is rendered moot. In addition, it is respectfully noted that claim 15 depends from claim 11 which is submitted as being allowable for defining over Abraham in view of Dickens et al. Moreover, it is respectfully noted that use of arrester protection and filtering at a "conventional outlet" does not cure the deficiencies noted above with respect to Abraham and Dickens et al.

The Examiner alleges that Cooper et al. illustrate (Figs. 1 - 3) arrester protection and filtering within a housing for applications at a conventional wall outlet and that it would have been obvious to incorporate the teachings of Cooper et al. as a means to obtain the ability to communicate over the power lines, via bandpass filtering/coupling, from an appliance located at the wall outlet.

Cooper et al. disclose an electrical circuit and method for use in suppressing source and load-side transients appearing on a power-supply line. (See Abstract). In particular, Cooper et al. disclose a plug 14 inserted into a wall receptacle (not shown) and the AC power cord (not

shown) from the load circuit 34 to be protected is inserted into receptacle 16. Col. 9, lines 6-8. AC power lines 30 and 32 supply power to an electrical load 34. Col. 9, lines 23-24. Thus, Cooper et al. merely disclose a single phase (120V) supply line and do not teach or suggest at least two high potential terminals being adapted for connection to at least two corresponding high potential lines disposed in said outlet receptacle, each high potential terminal being exposed at said base of housing, as in claim 11 from which claim 15 depends. Furthermore, Cooper et al. do not teach or suggest a pair of plug-in terminals connecting to each high potential terminal of said outlet receptacle, the plug-in terminals configured to electrically and mechanically connect to corresponding high potential receptacle terminals of said outlet receptacle, as in claim 15. Thus, claim 15 defines over Abraham in view of Dickens et al. and Cooper et al.

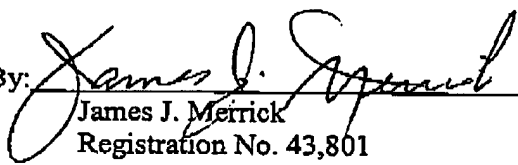
Conclusion

Applicants respectfully submit that all outstanding have been addressed and the present application is in condition for allowance. Reconsideration and allowance thereof is most earnestly and respectfully requested. Should any issue remain outstanding, Applicants respectfully request the Examiner telephone the undersigned at the number below to quickly resolve any such issues.

If there are any charges with respect to this amendment, or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

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